REMARKS/ARGUMENTS

Claims 1-21 are pending in the application. Claims 1-21 stand rejected.

In the Claims:

Rejection of Claim 1 and 2 under 35 USC §102(b) as anticipated by US 4,491,444

Independent Claim 1 stands rejected under 35 U.S.C. §102 (b), as anticipated by US 4,491,444 to Rumpp et al. The Examiner states that in Rumpp '444 the claimed "'forward most' condition is always maintained when the sliding sleeve is moved axially forward (to the left) and cam (7a), as shown in Figure 2, is engaged in the circumferential slot (3f) of slot (3d) to retain sliding sleeve (7) in this non-percussion drilling position." Furthermore, the Examiner states that the previously added claim limitations regarding the mode of operation of the tool holder and rotary hammer do not provide any additional structure that would distinguish the claimed invention over the prior art.

In order to provide for locking a tool shank in a tool holder for rotary drilling (only), Rumpp '444 provides a complex tool holder that can simultaneously hold the tool shank 1 without axial freedom and out of contact with the anvil 2. Rumpp '444 col. 5 lines 12-31. The Rumpp '444 tool holder could employ bits that could be used in either drilling or hammer-drilling modes. In contrast, the present invention provides a modified tool shank that can be accepted in a simpler and more common SDS type tool holder, but which due to its dimensions cannot be touched by the beatpiece/anvil, regardless of the selected mode of operation of either the rotary hammer and/or its tool holder. The bits of the present application could not be used for hammer-drilling.

Therefore, the Applicant has amended Claim 1 to delete the limitations added by the previous amendment and now amends the last section of claim 1 to read:

> a shank at the rearward end, the shank defining a closed groove for engagement by the locking body of the rotary hammer and for permitting limited axial movement of the tool between a frontmost and backmost position, and wherein the closed groove

> has a forward end which is located sufficiently close to the rearward end of the tool so that, when the tool is located in the backmost position, the rear end of the tool is maintained forwardly of the forwardmost position of the beatpiece.

As amended, Claim 1 requires that the tool shank and its rearward end, when located in the tool holder, are capable of reaching a "backmost position", and the beatpiece can achieve a "forwardmost" position, but that the proximity of the front end (12a) of the closed groove (12) to the rearward end (3) of the shank (2) will ensure that the rear end of the tool is maintained forward of the forward most position of the beatpiece (22). As used in Claim 1, "frontmost" and "backmost" are understood in view of the Specification to mean the most extreme positions that the beatpiece (22) and shank (2), respectively, can reach under any and all conditions, and does not refer to more limited positions imposed by certain operating modes of the rotary hammer and/or tool holder.

In contrast, Rumpp '444 discloses a mechanism wherein by manipulation of sliding sleeve 7, the locking member 6 and tool shank 1 are pushed into and held in a forward position. In that forward position, the shank 1 is prevented from achieving its "backmost" position, wherein it could be struck by the anvil 2. *See* Rumpp '444 col. 5 lines 12-31. Thus, Rumpp does not disclose a mechanism where "when the tool is located in the backmost position, the rear end of the tool is maintained forwardly of the forwardmost position of the beatpiece" as required by Claim 1.

The Applicant submits that amended Claim 1 and its dependent claims are distinguished over Rumpp '444 and are allowable.

Independent Claims 12 and 19 and Dependent Claims 10 and 11 all impose a limitation on the maximum distance from the forward end (12a) of the closed groove (12) to the rear end (3) of the shank (2).

Claims 10, 11, and 12 stand rejected under 35 USC 103(a) as unpatentable over "Rumpp et al. '444 in view of Kleine '519." The Examiner acknowledges that Rumpp '444 does not disclose the distance between the forward end of the closed groove and the rearward end of the tool being between 14 mm and 20 mm, but the Examiner claims to find such a teaching in Kleine '519 and states that it would have been obvious to modify Rumpp '444 in view of Kleine. Paragraph 9 at page 5 of the Action. Regarding claim 19, the Examiner again relies on Kleine '519 in combination with Rumpp '444 and Obermeier '682.

Independent claims 12 and 19 (and all their dependent claims) and dependent claims 10 and 11 (which depend from independent claim 1) all include numerical limitations to the distance between the forward end (12a) of the closed groove (12) and the rearward end (3) of the tool. Claim 10 requires that distance to be less than 20 mm. Claims 11, 12, and 19 require that distance to be between 14 mm and 20 mm. The Applicant believes that these numerical limitations would ensure that such a bit, when installed in a rotary hammer for use with SDS type bits, would be held in the tool holder forward of the forwardmost position of the beat piece, even when the hammer is placed in hammer-only mode or rotary-hammer mode.

As noted by the Examiner in his paragraph 9, US 4,840,519 to Kleine teaches that the "distance 19 from the front end 21 of the groove 15 to the rear end of surface 18 is at least 40 mm, and preferably at least 45 mm, in the case of all bits." Kleine '519 at col 5 lines 4-6 (emphasis added). The Applicant fails to see how this disclosure teaches the limitation of the same dimension to "less than 20mm", as in claim 10, or "between 14 mm and 20 mm," as in claims 11, 12, and 19. Indeed, by teaching minimum distances greater than the maximum claimed, Kleine '519 teaches away from the claimed inventions.

Furthermore, the structures described in Kleine '519 apparently function in the convention manner to allow a drill's percussion mechanism to strike the end of the shank. See Kleine '519 col. 1 lines 16-23 and col. 5 lines 52-55. Thus, Kleine '519 does not suggest the problem identified and solved in the present application – to locate the front end of the closed groove a sufficiently short distance from the rear end that, regardless of the hammer drill's operating mode, the percussion mechanism can not strike that rear end. Therefore, The Applicant does not understand how Kleine would motivate or suggested the modification of Rumpp '444 as described by the Examiner.

Therefore, the Applicants urge that dependent claims 10 and 11, claims 12-18, and claims 19-21 are allowable over the cited combinations including Kleine '519.

For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance and favorable consideration thereof is requested.

Respectfully submitted

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